

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Page 1 of 4

Appellants file this Request for Rehearing because the Board misapprehended the Examiner's rejection and, in consequence, affirmed the rejection rather than affirming the result on different reasoning. The Board therefore failed to designate its Decision on Appeal as a new ground of rejection, which has important procedural implications.

One recurring point of disagreement throughout the prosecution has been the interpretation to be given to the phrase in claim 1 "a distal tip having a *shapeable length*..." Appellants have consistently maintained that this is a structural limitation and should be so interpreted. See, for example, page 9 of the Appeal Brief of September 28, 2004. The Board agreed, saying "We agree with Appellants that the word 'shapeable' should be understood as meaning 'capable of being shaped'. Thus, it is a material property of a portion of the recited device." Decision on Appeal, page 9 (some quotation marks omitted).

The Board errs in saying that "[t]he Examiner has reasonably established a prima facie case of unpatentability at least based on inherency." Decision on Appeal, page 10. To the contrary, the Examiner has never asserted that "a distal tip having a shapeable length" is a material property of the device inherent in the cited prior art. The Examiner has consistently interpreted this language as a product-by-process limitation.

For example, the Examiner's Answer (Item 10) says, "The applicant argues that the examiner has interpreted 'shapeable by thermoforming techniques' as a product by process claim recitation. This is not true. The examiner is interpreting that statement as a product by process limitation and has given that limitation the full scope as suggested by the MPEP, in sections 2112.01, 2112.02 and 2113." Emphasis added. The Examiner goes on to say "[Section 2173.05(p)(I)] does not give any insight into how to interpret claims that have process limitations in an apparatus claim" (page 4) and "In claim 1, 'the distal tip having a shapeable length that is

shapeable by thermoforming techniques', is being interpreted as a functional statement, with a product-by-process limitation" (page 4) and "The next limitation 'by thermoforming techniques' is the process limitation, which results in the product being shapeable" (page 4) and "With regards to *In re Thorpe* the examiner used this case law to show that the patentability of the product (the catheter) does not depend on its method of production (thermoforming techniques) but on the finally [sic] product" (page 5), and so on.

The Examiner's Answer is consistent with the Examiner's position throughout prosecution. In item 6 on page 5 of the Final Office Action of January 28, 2004, the Examiner writes "the examiner holds the limitation 'shapeable by thermoforming techniques' to be a product by process limitation." In item 6 on page 5 of the Office Action of August 12, 2003, the Examiner writes "since this limitation is a product by process limitation."

Never in the course of prosecution does the Examiner claim that the "shapeable" limitation is a material property of the recited device, and never does the Examiner assert the inherency of this limitation in Samson.

The reasoning in the Decision on Appeal is based on the "shapeable" limitation being a material property inherent in Samson. This is a substantially different basis for the rejections than product-by-process reasoning advanced by the Examiner. Significantly, Appellants never had an opportunity to respond to a rejection based on inherency because such a rejection was, prior to the Decision on Appeal, never applied.

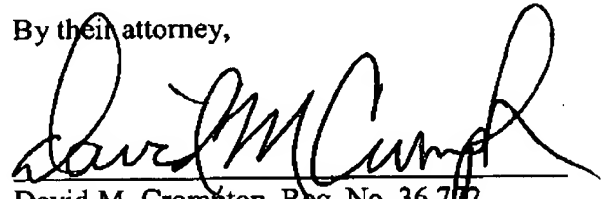
Appellants therefore request that the Board correct this misapprehension of the Examiner's basis for rejection in the Decision on Appeal by issuing a corrected Decision on Appeal, or its equivalent, that designates the Board's reasoning as a new grounds of rejection.

Respectfully submitted,

Ting Tina Ye, et al.

By their attorney,

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